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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,036	03/25/2004	Neil Andrew Simpson	CRU/0011	5819
7590 04/17/2009 WILLIAM B. PATTERSON MOSER, PATTERSON & SHERIDAN, L.L.P. Suite 1500 3040 Post Oak Blvd. Houston, TX 77056				
EXAMINER SULLIVAN, DEBRA M				
ART UNIT 3725		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

## Application No.

10/809,036

## Applicant(s)

SIMPSON ET AL.

## Examiner

Debra M. Sullivan

## Art Unit

3725

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) 8, 11, 16, 19, 27, 33, 35, 36, 39, 40, 46, 49, 82 and 92-94 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) See Continuation Sheet is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-848)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

Continuation of Disposition of Claims: Claims pending in the application are 1-3,5-21,26-41,43,44,46,48-55,82-86,90-101,103-105,107-109 and 111-115.

Continuation of Disposition of Claims: Claims rejected are 1-3,5-7,9-15,17,18,20,21,26,28-32,34,37,38,41,43,44,48,50-55,83-86,90,91,95-101,103-105,107-109 and 111.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 9, 2009 has been entered.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 5-7, 9, 10, 12-15, 17, 18, 20, 21, 26, 28-31, 34, 38, 41, 43, 44, 48, 50-55, 83-86, 90, 91, 95-101, 103-105, 107-109 and 111-115 rejected under 35 U.S.C. 102(e) as being anticipated by De Lucia et al (US 2006/0108123). De Lucia et al discloses a method of expanding tubing, the method comprising locating an expansion device (202) on a workstring (204) in tubing (208) to be expanded, wherein the workstring extends from a surface of a wellbore (24), creating a vibration with fluid flowing through at least one of the expansion device (202), vibrating at least one of the expansion device (202) and the tubing (208), and translating the expansion device (202) relative to the tubing (208) by applying a constant driving

force to the expansion device (202) via the workstring thereby expanding the tubing (208) [See paragraphs 0030-0033].

In reference to claims 2 and 3, the vibration of the at least one of the tubing (208) and the expansion device (202) to minimize static friction between contacting surfaces of the expansion device (202) and the tubing (208) [See paragraph 0033].

In reference to claim 5, the driving force remains constant as the expansion device (202) is translated through the tubing (208) [See paragraph 0032].

In reference to claim 6, a direction of the vibration is multi-directional.

In reference to claims 7, 9, 10, 12-15 and 18, De Lucia et al further discloses the expansion device (202) being subject to vibration in addition to the tubing (208) being subject to vibration that induces physical movement of the tubing [See paragraph 0033].

In reference to claim 17, the vibration takes the form of at least one wave traveling through at least one of the expansion device (202) and the tubing (208).

In reference to claim 20, De Lucia et al further discloses creating the vibration with a moving mass (fluid) [See paragraph 0025].

In reference to claim 21, De Lucia et al further discloses providing a varying restriction through at least one of the expansion device (202).

In reference to claim 26, De Lucia et al discloses a source of vibration (206) is coupled to the tubing (208), as seen in figure 3a

In reference to claim 28, the source of vibration (206) is indirectly coupled to the expansion device (202) through the tubular (208).

In reference to claims 29-31, 34, 38, 41, De Lucia et al further discloses the amplitude and the frequency to be constant thus forming a constant vibration [See paragraph 0033].

In reference to claims 43 and 44, the driving force is a mechanical driving force that provides a pushing force on the expansion device (202) [See paragraph 0032].

In reference to claims 48 and 50, the expansion device (202) is translated axially relative to the tubing (208) thus creating a localized compressive yield in the tubing wall, as see in figure 3a.

In reference to claim 51, the expansion device (202) comprises of a varying diameter, as seen in figure 3a.

In reference to claims 52-54, De Lucia et al further discloses creating a pressure differential across a wall of the tubing (208) that is varied and cycled.

In reference to claim 55, De Lucia et al further discloses isolating a volume of fluid containing the expansion device (202).

In reference to claims 90 and 91, De Lucia et al discloses inserting the tubing (208) into a wellbore prior to translating the expansion device (202) relative to the tubing (208) [See paragraph 0032].

In reference to claim 95, the driving force remains constant as the expansion device (202) is translated through the tubing (208) [See paragraph 0032].

In reference to claim 112, the tubing of De Lucia et al is plastically deformed to a larger diameter when expanding the tubing (208), as seen in figure 3a.

In reference to claim 83, De Lucia et al discloses a method of expanding tubing (208), the method comprising the steps of locating an expansion device (202) in tubing (208) to be

expanded, vibrating at least one of the tubing (208) and the expansion device (202), translating the expansion device (202) relative to the tubing (208) thereby expanding the tubing (208) and creating the vibration by varying a pressure of fluid operatively associated with the at least one tubing (208) and expansion device (202) [See paragraphs 0030-0033].

In reference to claims 96 and 97, the tubing is inserted into a wellbore (24) prior to translating the expansion device (202) relative to the tubing (208).

In reference to claims 98 and 99, a driving force is applied to translate the expansion device (202) through the tubing (208) wherein the driving force remains constant [See paragraph 0032].

In reference to claim 113, the tubing of De Lucia et al is plastically deformed to a larger diameter when expanding the tubing (208), as seen in figure 3a.

In reference to claim 84, De Lucia et al discloses a method of expanding tubing (208), the method comprising the steps of locating an expansion device (202) in tubing (208) to be expanded wherein the expansion device is coupled to a workstring (204), vibrating at least one of the tubing (208) and the expansion device (202), moving the workstring (204) and the expansion device (202) relative to the tubing by applying a constant driving force thereby expanding the tubing (208) to a larger diameter, and creating vibration by creating pressure pluses in a fluid operatively associated with at least one of the expansion device (202) and the tubing (208) [See paragraphs 0030-0033].

In reference to claims 100 and 101, the tubing is inserted into a wellbore (24) prior to translating the expansion device (202) relative to the tubing (208).

In reference to claim 103, the driving force remains constant as the expansion device (202) is translated through the tubing (208) [See paragraph 0032].

In reference to claim 85, De Lucia et al discloses a method of expanding tubing (208), comprising the steps of locating an expansion device (202) on a workstring (204) in tubing (208) to be expanded, vibrating at least one of the tubing (208) and the expansion device (202), pushing the workstring (204) to translate the expansion device (202) and the workstring (204) relative to the tubing (208) thereby expanding the tubing (208) and applying a fluid pressure driving force to translate the expansion device (202) relative to the tubing (208) [See paragraphs 0030-0032].

In reference to claims 104 and 105, De Lucia et al further discloses inserting the tubing (208) into a wellbore (24) prior to translating the expansion device (202) relative to the tubing (208).

In reference to claim 107, the driving force remains constant as the expansion device (202) is translated through the tubing (208) [See paragraph 0032].

In reference to claim 114, the tubing of De Lucia et al is plastically deformed to a larger diameter when expanding the tubing (208), as seen in figure 3a.

In reference to claim 86, De Lucia et al discloses a method of expanding tubing (208), comprising the steps of locating an expansion device (202) in tubing (208) to be expanded, wherein the expansion device is in rolling contact with the tubing, vibrating at least one of the tubing (208) and the expansion device (202), translating the expansion device (202) relative to the tubing (208) by applying a constant driving force thereby expanding the tubing (208) to a larger diameter [See paragraphs 0030-0032 and FIG 3a].

In reference to claims 108 and 109, De Lucia et al further discloses inserting the tubing (208) into a wellbore (24) prior to translating the expansion device (202) relative to the tubing (208).

In reference to claim 111, the driving force remains constant as the expansion device (202) is translated through the tubing (208) [See paragraph 0032].

In reference to claim 115, De Lucia et al discloses a method of expanding tubing (208), comprising the steps of isolating a portion of the tubing (208) containing an expansion device (202), applying a base pressure to the isolated portion of tubing (208), the base pressure creating a differential pressure across a wall of the tubing (208) below the yield pressure of the tubing wall, vibrating at least one of the tubing (208) and the expansion device (202) by varying the base pressure and expanding the isolated portion of tubing utilizing the expansion device (202) [See paragraph 0030-0033 and FIG 3a].

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 32 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over De Lucia et al in view of Burge (US 2005/0145390). De Lucia et al discloses the invention substantially as claimed except for wherein the vibration is greater than 100 Hz. However, Burger teaches that the frequency typically depends upon the size and type of tubing and therefore it may be necessary to adjust the frequency of the vibrations accordingly. Therefore, it

would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the range of the frequency of De Lucia et al to be greater than 100 Hz or within a range of 1 to 100 Hz, since it has been held that where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation [*In re Aller*, 105 USPQ 233].

### ***Response to Arguments***

Applicant's arguments with respect to claims 1, 83-86 and 115 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Debra Sullivan whose telephone number is (571) 272-1904. The examiner can normally be reached Monday - Thursday 10am - 8pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dana Ross can be reached at (571) 272-4480. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Debra M Sullivan/  
Examiner, Art Unit 3725

/Dana Ross/  
Supervisory Patent Examiner, Art Unit 3725